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| 10/029,559      | 12/20/2001  | Michael V. Chobotov  | 24641-7005          | 4960             |

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EXAMINER

PREBILIC, PAUL B

ART UNIT PAPER NUMBER

3738

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/029,559

Applicant(s)

CHOBOTOV ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### ***Specification***

The disclosure is objected to because of the following informalities:

On page 1, lines 4-14, the continuing data is not restricted to related cases (e.g. continuation, continuation-in-part, or divisional applications), and therefore, it is not proper for a statement of related cases.

In addition, the continuing data on page 1 has three blank spaces for serial numbers such that it is incomplete.

Furthermore, the continuing data may need to be updated with the current status of any related cases; e.g. patent number or abandoned status.

On page 19, lines 14-15, there are blank lines for serial numbers making the disclosure information incomplete. Also, Applicants are respectfully requested to insert the patent numbers for any applications that are now patented.

On page 52, lines 5-6 and page 54, line 12, the blank lines need to be filled out or deleted to make the disclosure information complete.

In the drawings, the second copy of Figure 1 is not necessary and is considered extraneous. Instead, the Examiner will treat it as an extraneous copy making the present disclosure to contain 14 pages of drawings with 16 figures.

There is no label of "Detail A" (Figure 5) in the figures even though it is referred to in the specification; see page 5, line 3.

Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-71 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-87 of copending Application No. 10/327,711. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed inventions of the copending application and the present application are so similar to each other that they read on each other. For this reason, the Examiner asserts that they are obvious in view of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 5, 6, 9-14, 42-44, 46-51, and 53-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Piplani et al (US 5,489,295). Piplani anticipates the claim language where the graft body as claimed is the graft (20) of Piplani, the connector member as claimed is the suture material (144) of Piplani, the proximal stent as claimed is the expandable spring (126), and the proximal stent connector elements as claimed are the coil springs (203); see column 5, line 1 to column 6, line 2, column 7, lines 25-51, Figure 4, and Figure 8.

Claims 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by McDermott et al (US 6,312,462). McDermott anticipates the claim language; see Figure 7 as well as Figures 4, 5, and 7, the abstract and column 5, lines 22-45.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piplani et al (US 5,489,295) alone.

Piplani meets the claim limitations as set forth in the Section 102 rejection above but fails to disclose the length of the barbs used therein. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the barbs 2 to 5 mm in length as claimed because Applicants have not disclosed that making barbs of this length provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well because it appears to be within an order of magnitude of the claimed range upon inspection of the drawings. Therefore, it would have been an obvious matter of design choice to modify Piplani to obtain the invention as specified in the claims.

Claims 16-21, 36-38, 41, 62, 64, 65, 66, 67, 70, and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piplani et al (US 5,489,295) in view of McDermott et al (US 6,312,462) or Holman et al (US 6,319,276). Piplani meets the claim language as explained *supra*. However, Piplani fails to disclose the inflatable cuff and other inflatable portions of the graft as claimed. McDermott and Holman both teach

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that inflatable grafts with inflatable cuffs and lengths thereof were known to the art at the time the invention was made; see McDermott in Figures 4, 5, and 7 as well as the abstract and column 5, lines 22-45 and see Holman in the abstract, Figures 3, 6, and 9 as well as column 3, line 38 to column 4, line 15. Therefore, it is the Examiner's position that it would have been obvious to replace the graft of Piplani with the graft of either McDermott or Holman so as to prevent collapse of the graft in the middle section, to better support the vessel along the length thereof, and for the same reasons that McDermott and Holman use the same.

With regard to claims 21 and 36 specifically, both McDermott and Holman teach curable fillers, but they fail to disclose the cure time and resultant modulus as claimed. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to adjust the cure time to be within the time for a surgical procedure because Applicants have not disclosed that the particular cure time provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well it is designed to be inserted and cure within the time of a surgical procedure. Therefore, it would have been an obvious matter of design choice to modify Holman or McDermott to obtain the invention as specified in the claims.

With regard to claim 37, Piplani teaches the use of radiopaque sutures (121), but not radiopaque material in the filling medium as claimed. However, since Piplani teaches the broad concept of making the graft radiopaque along the length thereof, it is

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the Examiner's position that it would have been prima fascia obvious to put radiopaque material in the filler material of Piplani as modified by McDermott or Holman for the same reasons that Piplani puts radiopaque sutures along the length of the graft.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott et al (US 6,312,462) alone. McDermott meets the claim as set forth in the Section 102 rejection above, but fails to disclose the dilute solution of saline. However, since McDermott discloses saline as a filler material, it would have been considered prima fascia obvious to use dilute saline absent some showing of unexpected and unobvious result.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.



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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilit  
Primary Examiner  
Art Unit 3738